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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,000	12/21/2000	John Dawson	BEV9	2939
33277	7590	10/21/2003	EXAMINER	
JOHN D. WATTS 8301 GUTHERIE AUSTIN, TX 78750			NGUYEN, TRINH T	
		ART UNIT		PAPER NUMBER
		3644		

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/747,000	DAWSON, JOHN
	Examiner Trinh T Nguyen	Art Unit 3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

16414 Rep'y  
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- If FAILURE to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 July 2003 .

2a)  This action is **FINAL**. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage  
application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.  
14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.  
15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the Appeal Brief filed on 7/14/03, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following are examples only:

In claim 1: the phrase "to increase the critical area at the end of thread engagement for an integral threaded connection for like joints that may be as strong selectively, as the pipe strength" is confusing and it is not understood what is being

claimed (i.e., it is unclear as to what the terms "the critical area" and "the end of thread engagement" define and/or intend to be encompassed); also, the terms "the critical area" and "the end of thread engagement" lack proper antecedent basis.

In claim 2: the phrase "a counterbore of predetermined length" is confusing (i.e., is this "predetermined length" is equivalent to "the predetermined end-length" as claimed in claim 1?); the phrase "the first configuration" is confusing (i.e., is this "the first configuration" is equivalent to "the first configuration" as claimed in claim 1 or is this "the first configuration" is equivalent to "a desired first inner configuration" as claimed in line 2 of claim 2?); the phrase "the original pipe outer diameter" is confusing (i.e., is this "the original pipe outer diameter" is equivalent to "the outer pipe diameter" as claimed in claim 1?); the phrase "the end-length" is confusing (i.e., is this "the end-length" is equivalent to "the end-length" as claimed in claim 1 or is this "end-length" is equivalent to the "predetermined length" as claimed in line 2 of claim 2?); the phrase "such that the box thread maximum diameter exceeds the pipe outer diameter" is confusing (i.e., it is unclear as to what the term "the box thread maximum diameter" defines and/or intends to be encompassed and it is unclear as to what the term "the pipe outer diameter" is referred to (i.e., "the outer pipe diameter" as claimed in claim 1 or "the original pipe outer diameter" as claimed in claim 2?)); and the terms "the box thread maximum diameter" and "the pipe outer diameter" lack proper antecedent basis (note that claim 3 has similar problems as of in claim 2).

The above noted defects are merely representative and not intended to be a complete listing thereof. Applicant is required to rewrite the claims into a format which

can be more readily understood and to make corrections to all the claims wherever appropriate in order to clarify same if the prosecution is continued.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 1, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by Reed et al. (US 6,024,646).

Reed et al. disclose a method of forming end-length of plain-end pipe joint having an inner and an outer pipe diameter so as to provide desired final dimensions comprising: machining a predetermined end-length of the pipe joint so as to effect a desired first configuration (59, 57, 53 in Figure 2); swaging the first configuration to have a desired inner second configuration (67, 63 in Figure 3) and a desired outer third configuration (65 in Figure 3); and machining the end-length to effect the desired final

dimensions for the end-length (21, 69, 18, 71 in Figure 4) (Also see lines 25-67 of col. 3, lines 1-65 of col. 4, and lines 1-65 of col. 7).

***Allowable Subject Matter***

6. Claims 2-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

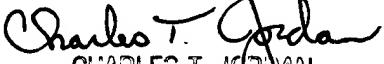
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached on (703) 306-4159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

ttn  
10/16/03

  
CHARLES T. JORDAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600